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In re Application of :
ELLIOTT, et al. :
Application No.: 10/554,917 :
PCT No.: PCT/US04/09215 : DECISION ON PETITION
Int. Filing Date: 24 March 2004 :
Priority Date: 30 April 2003 : UNDER 37 CFR 1.47(a)
Atty. Docket No.: 039386-2277 :
For: KINASES AND PHOSPHATASES :

This decision is in response to the applicant's petitions under 37 CFR 1.47(a) filed 05 October 2006 in the United States Patent and Trademark Office (USPTO). Applicant is advised that the required petition fee is \$200.00. There is no need to provide the petition fee for each of the non-signing inventors. As such, \$1360.00 will be refunded to applicant's credit card.

BACKGROUND

On 24 March 2004, applicant filed intefnational application PCT/US04/09215 which claimed priority to an earlier U.S. application filed 30 April 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 30 October 2005.

On 31 October 2005, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a First preliminary amendment.

On 05 June 2006, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 05 October 2006, applicant filed the present petition under 37 CFR 1.47(a) accompanied by a petition for a two-month extension of time and payment of the appropriate petition fee. With the filing of the petition for a two-month extension of time and payment of the appropriate extension of time fee, the present response is considered timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(i), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. With the filing of the present petition and accompanying papers, applicant has satisfied items 1 and 3.

As to item (2), applicant has satisfied this item for inventors: Li, Lu, Ernestine Lee, Ison, Gururajan, Nguyen and Swarnaker. Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part: Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47... The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as Internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should include a statement of facts. It is important that the statement contain facts as opposed to conclusions.

Regarding inventors Wilson, Gandhi and Marquis, applicant has evidence that the Fed Ex parcel was either left at the residence without a signature required or that the address was incorrect. While applicant did include results of searches to find a current address, these searches did not include looking for the inventor by name. In the instance of inventor Thornton, applicant has included search results based on a search of the inventor's name; however it does not appear from the petition and accompanying papers that applicant followed up on any of the results in order to find a current address for Mr. Thornton. Lastly, as to inventor Soo Yean Lee, applicant searched by the inventor's address, however, this address appears to be an apartment building. It does not appear that applicant searched for Ms. Lee by name.

Regarding item (4), the filed declaration does not comply with 37 CFR 1.497(a)-(b). The international application identifies an inventor Narinder K. Chawla. However, the filed declaration lists this inventors as Narinder K. Chawla-Walia. In order to proceed in the U.S. National stage a petition under 37 CFR 1.182 changing the inventor's name is required. See the Manual of Patent Examining Procedure at § 605.04(c).

For the reasons stated above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED without prejudice.**

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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